

U.S. Patent Application No.: 10/667,492
Attorney Docket No.: 57941.000023
Client Reference No.: RA297.P.US

IN THE DRAWINGS:

Please add Figures 13-16 by adding 4 new drawing sheets (each designated as "New Sheet") containing added Figures 13-16 as indicated in attached Appendix A.

REMARKS

The Office Action dated January 8, 2007, has been received and carefully considered. In this response, the specification and claims 1 and 11 have been amended, Figures 13-16 have been added, and claim 10 has been cancelled without prejudice. Entry of the amendments to the specification and claims 1 and 11, the addition of Figures 13-16, and the cancellation of claim 10 without prejudice is respectfully requested. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.

I. THE OBJECTION TO THE DRAWINGS

On pages 2-3 of the Office Action, the drawings were objected to under 37 CFR § 1.83(a) for failing to show every feature of the claimed invention.

While Applicants believe the claimed invention is well supported throughout the specification, Applicants have acceded to the request of the Examiner by proposing 4 new drawings (i.e., attached Figures 13-16) to be added which directly support the claimed invention, and vice versa. Corresponding amendments to the specification are also proposed. No new matter is added with the new drawings or the corresponding text. Approval by the Examiner is respectfully requested.

In view of the foregoing, it is respectfully requested that the aforementioned objection to the drawings be withdrawn.

II. THE ENABLEMENT REJECTION OF CLAIMS 1-11

On page 3 of the Office Action, claims 1-11 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. This rejection is hereby respectfully traversed.

The Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Specifically, the Examiner asserts that the specification fails to describe a "transition-limiting code."

Applicants respectfully disagree. Specifically, Applicants respectfully submit that the specification is replete with descriptions of transition-limiting codes (e.g., see from page 3, line 18, to page 4, line 12; from page 11, line 1, to page 13, line 4; page 20, lines 15-19; etc.). Also, the two provisional applications (i.e., U.S. Provisional Patent Application Nos. 60/450,349 and 60/494,561) to which the present application claims priority, and the entirety of which are incorporated by reference in the present application, are equally replete with descriptions of transition-limiting codes.

At this point it should be noted that, as stated in MPEP § 2163.02, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed. The subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement.

In view of the foregoing, it is respectfully requested that the aforementioned enablement rejection of claims 1-11 be withdrawn.

III. THE NON-STATUTORY SUBJECT MATTER REJECTION OF CLAIMS 1-11

On pages 3-4 of the Office Action, claims 1-11 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is hereby respectfully traversed.

The Examiner asserts that claims 1-11 are not directed to an invention that as a whole accomplishes a practical application. While Applicants respectfully disagree, in order to further the present application toward allowance, Applicants have amended claim 1 to recite the practical application of employing the selected transition-limiting code in the multi-level signaling system to at least reduce a number of full-swing

transitions between sequential signals. Applicants respectfully submit that this recitation provides an additional useful, concrete, and tangible result to the claimed invention.

Regarding claim 10, the Examiner asserts that a signal is not statutory subject matter. This very issue is before the U.S. Court of Appeals for the Federal Circuit at the moment in the case stylized In re Petrus A.C.M. Nuijten (Appeal No. 06-1371). Applicants have cancelled claim 10, but reserve the right to add this claim again depending upon the court's decision on the issue.

Regarding claim 11, Applicants have amended claim 11 to recite a storage medium, as supported by the specification.

In view of the foregoing, it is respectfully requested that the aforementioned non-statutory subject matter rejection of claims 1-11 be withdrawn.

IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the

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present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By: 

Thomas E. Anderson

Registration No. 37,063

TEA/vrp

Hunton & Williams LLP
1900 K Street, N.W.
Washington, D.C. 20006-1109
Telephone: (202) 955-1500
Facsimile: (202) 778-2201

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APPENDIX A